

REMARKS

In the Office Action,¹ the Examiner rejected claims 1-10, 22, 34, and 46 under 35 U.S.C. § 112, second paragraph; rejected claims 1-48 under 35 U.S.C. § 101; and rejected claims 1-48 under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 5,422,821 to *Allen* in view of a web archive to *Anchor*.

By this Response, Applicants have amended claims 1, 4, 6-13, 16, 18-25, 28, 30-37, 40, and 42-48. Claims 2, 3, 14, 15, 26, 27, 38, and 39 have been cancelled without prejudice or disclaimer, and the rejections of these claims are rendered moot. New claims 49-56 have been added. Claims 1, 4-13, 16-25, 28-37, and 40-56 are pending.

35 U.S.C. § 112

Applicants respectfully traverse the rejection of claims 1-10, 22, 34, and 46 under 35 U.S.C. § 112, second paragraph. However, in order to advance prosecution:

- with respect to claim 1, references to “the first address” have been deleted;
- with respect to claims 10 and 11, the claims have been amended to recite “at least one of receiving and outputting”; and
- with respect to claims 10, 22, 34, and 46, the claims have been amended to recite the claimed elements in the alternative.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Applicants submit that the claims as amended fully comply with 35 U.S.C. § 112, second paragraph, and request that the Examiner withdraw the rejections of claims 1-10, 22, 34, and 46 under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 1-48 under 35 U.S.C. § 101. The Examiner alleged that claims 1, 13, 25, and 37 used “open-ended conditional language” which “would not render the entire claim useful, tangible or concrete.” Office action, Page 3. However, claims 1, 13, 25, and 37, as amended, recite the useful, tangible, and concrete result of “outputting the correct address.” The claims as currently amended are not “open-ended” or “conditional.” Therefore, since non-statutory alternatives are not positively recited in the claims, the unclaimed alternatives should not form the basis for a rejection under 35 U.S.C. § 101. Accordingly, Applicants request that the Examiner withdraw the rejection of claims 1-48 under 35 U.S.C. § 101. The Examiner is encouraged to contact the undersigned to discuss the claim language in the event that the Examiner is not persuaded that the claims are directed to statutory subject matter.

Rejection of claim 1-48 under 35 U.S.C. § 103 as being obvious under *Allen* in view of *Anchor*

Applicants respectfully traverse the rejection of claims 1-48 under 35 U.S.C. § 103. No *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, the prior art, even if combined, must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based

upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, the prior art does not teach or suggest each and every element of Applicants’ claims.

Amended claim 1 recites, *inter alia*, “comparing [a] second instance of [an] incorrect address” to a “resolved address” comprising “[a] correct address and [a] first instance of an incorrect address.” As recited in Applicant’s specification at paragraph 49, an “incorrect” address is an address which “does not match information” in a standardized address database, such as the ZIP+4 database.

Allen does not teach or suggest “comparing [a] second instance of [an] incorrect address” to a “resolved address” comprising “[a] correct address and [a] first instance of an incorrect address,” as recited in claim 1. *Allen* instead compares “delivery point information” to “an extract of the USPS . . . database . . . to determine if a forwarding request has been logged against that delivery point.” Column 6, line 65-Column 7, line 4. If a “match” occurs, “reprocessing” occurs to forward the mail. Column 7, lines 8-21. If a “match” does not occur, information about the mailpiece is “erased from memory.” Column 7, lines 59-61. However, neither this portion of *Allen*, nor any other portion constitutes “comparing [a] second instance of [an] incorrect address” to a “resolved address” comprising “[a] correct address and [a] first instance of an incorrect address,” as recited in claim 1.

Anchor fails to cure the deficiencies of *Allen*. The Examiner alleges that *Anchor* “processes your lists and makes all necessary address corrections. In addition, the powerful software will also standardize your addresses and add ZIP+4 Codes to your address file.” Office action, page 5. Even assuming that this allegation is true, which Applicants do not concede, *Anchor* fails to cure the deficiencies of *Allen* discussed above. That is, *Anchor* does not teach or suggest “comparing [a] second instance of [an] incorrect address” to a “resolved address” comprising “[a] correct address and [a] first instance of an incorrect address,” as recited in claim 1.

Anchor acknowledges that “mail is undeliverable because of incorrect addresses,” but *Anchor* uses a “master file of all permanent . . . residential and business change of address records.” Pages 1 and 4. After comparing a “mail file” to the “NCOA database” *Anchor* “drop[s] records for those who moved without providing a new address.” Page 2. However, neither this portion of *Anchor*, nor any other portion constitutes “comparing [a] second instance of [an] incorrect address” to a “resolved address” comprising “[a] correct address and [a] first instance of an incorrect address,” as recited in claim 1.

Accordingly, the prior art fails to establish a *prima facie* case of obviousness with respect to claim 1, at least because the prior art fails to teach each and every element required by the claim. Claim 1 is thus allowable over the art of record.

Claims 13, 25, and 37, though of different scope from claim 1, recite elements similar to those set forth above for claim 1. Claims 13, 25, and 37 are therefore allowable for at least the reasons presented above with respect to claim 1. Claims 1, 4-12, 16-24, 28-36, and 40-56 respectively depend from claims 1, 13, 25, and 37 and

are allowable at least for the reason of their dependency. Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 103.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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